

REMARKS

This is in response to the Office Action mailed May 22, 2003. In the Office Action, claims 60-64, 67-77, 80-85, 87-91, 93-100, 102-103, and 105-112 were rejected under 35 USC 102(e); and claims 60-99, 101-102, and 104 were rejected under 35 USC 103(a). Reexamination and reconsideration of this case is respectfully requested in view of the foregoing amendments and the following remarks.

In this response, claims 60, 70-71, 94, 95, 105, and 109-111 have been amended. New claims 113-116 have been added. Claims 1-59 were previously cancelled without prejudice. Accordingly, claims 60-116 remain at issue in the patent application. Of those remaining at issue, claims 60, 83, 94, 105, and 110 are independent claims.

Applicant believes that no new matter has been added by this response.

**I) CLAIM REJECTIONS - 35 USC § 102(e)**

Claims 60-64, 67-77, 80-85, 87-91, 93-100, 102-103, and 105-112 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,369,924 issued to Scharf, et al. (Scharf). Applicant respectfully traverses this rejection.

Claims 94, 96, 97, 105-107, and 109-112 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,072,613 issued to Henningsson, et al. (Henningsson). Applicant respectfully traverses this rejection.

Applicant has amended independent claims 60, 94, and 105 to clarify Applicant's claimed invention. Applicant has also amended claim 110 into independent form to clarify Applicant's claimed invention. Dependent claims 70-71 have been amended to correspond to the claim amendments of independent claim 60. Dependent claims 95 and 109 have been amended to further claim different aspects of the invention from the independent claims.

"To anticipate a claim, the reference must teach every element of the claim. 'A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' *Verdegaal Bros. V. Union Oil co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). 'The identical invention must be shown in as complete detail as is contained in the claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." [MPEP § 2131, Original 8<sup>th</sup> Edition, Aug. 2001, Pg. 2100-69].

#### A. Scharf

Regarding independent claims 60, 83, 94, and 105, Applicant respectfully submits that Scharf does not disclose every element of the claims.

Regarding independent claim 60, Scharf at least does not disclose "a base coupled to the shielded housing" as recited in amended claim 60. [Claim 60, line 11]. Applicant has thoroughly searched Scharf for the word "base" and can find no reference therein. Scharf does not disclose a base separate and apart from any shielded housing that is coupled to the shielded housing.

Moreover, Scharf does not disclose a "base extending along a length of and perpendicular to the first printed circuit board [with] the base having an opening for the one or more pins of the first printed circuit board to extend through" as further recited in amended independent claim 60. [Claim 60, lines 11-14].

Regarding independent claim 83, Scharf at least does not disclose "a shielded housing coupled to [a] base". [Claim 83, line 22]. Scharf does not disclose any shielded housing, separate and apart from any base, that is coupled to the base:

Moreover, Scharf does not disclose a "first printed circuit board having a pin inserted through a first opening in the base" and a "second printed circuit board having a pin inserted through a second opening in the base" as recited in claim 83. [Claim 83, lines 8-9 and 15-17].

Regarding independent claim 94, Scharf at least does not disclose "coupling a base to [a] shielded housing" as recited in amended claim 94. [Claim 94, line 20]. Scharf does not disclose any shielded housing, separate and apart from any base, that is coupled to the base.

Moreover, Scharf does not disclose a "base extending along lengths of the first printed circuit board and the second printed circuit board and being perpendicular thereto" as recited in amended claim 94. [Claim 94, lines 20-22].

Regarding independent claim 105, Scharf at least does not disclose a "base extending perpendicularly along a length of the first printed circuit board and having one or more openings from which the one or more pins of the first printed board extend" as recited in amended claim 105. [Claim 105, lines 11-14].

Regarding independent claim 110, Scharf at least does not disclose "a base coupled to the metallic shielded housing" as

recited in amended claim 110. [Claim 110, line 12]. Scharf does not disclose a base separate and apart from any metallic shielded housing that is coupled thereto.

Moreover, Scharf does not disclose a "base having one or more openings from which the one or more pins of the first printed board may extend" as recited in amended claim 110. [Claim 110 lines 13-15].

For the foregoing reasons, Applicant respectfully submits that Scharf does not anticipate or make obvious Applicant's independent claims 60, 83, 94, 105, and 110.

Rejected dependent claims 61-64, 67-77, and 80-82 depend from independent claim 60. Rejected dependent claims 84-85, 87-91, and 93 depend from independent claim 83. Rejected dependent claims 95-100, and 102-103 depend from independent claim 94. Rejected dependent claims 106-109, and 111-112 depend from independent claim 105.

Regarding dependent claims 70, 71, 76, 77, 109, and 110, the Office Action alleges that Scharf discloses "a base of the housing has openings from which the pins 40/41 of the PCBs extend". [Office Action, page 3, lines 19-20]. Applicant respectfully disagrees. As discussed previously, Scharf does not disclose a base separate and apart from any housing, and discloses no openings in any base through which pins of a printed circuit board extend.

Moreover, Applicant believes that it has placed independent claims 60, 83, 94, 105, and 110 in condition for allowance such that dependent claims depending therefrom with further limitations are also in condition for allowance.

For the foregoing reasons, Applicant respectfully requests the withdrawal of the 35 USC § 102(e) rejections of claims 60-

64, 67-77, 80-85, 87-91, 93-100, 102-103, and 105-112 over Scharf.

B. Henningsson

Regarding independent claims 94, 105, and 110 Applicant respectfully submits that Henningsson does not disclose every element of the claims.

Regarding independent claim 94, Henningsson at least does not disclose "providing a second printed circuit board spaced apart from the first printed circuit board" as recited in amended claim 94. [Claim 94, lines 8-9].

Moreover, Henningsson does not disclose a "base extending along lengths of the first printed circuit board and the second printed circuit board and being **perpendicular** thereto" as recited in amended claim 94. (emphasis added) [Claim 94, lines 20-22].

Regarding independent claim 105, Henningsson at least does not disclose a "base extending **perpendicularly** along a length of the first printed circuit board" as recited in amended claim 105. (emphasis added) [Claim 105, lines 11-13].

Regarding independent claim 110, Henningsson at least does not disclose "a base coupled to the metallic shielded housing **perpendicular** to the first printed circuit board" as recited in amended claim 110. (emphasis added) [Claim 110, lines 12-13].

For the foregoing reasons, Applicant respectfully submits that Henningsson does not anticipate or make obvious Applicant's independent claims 94, 105, and 110.

Rejected dependent claims 96 and 97 depend from independent claim 94. Rejected dependent claims 106-107, 109 and 111-112 depend from independent claim 105.

Applicant believes that it has placed independent claims 94, 105, and 110 in condition for allowance such that dependent claims depending therefrom with further limitations are also in condition for allowance.

For the foregoing reasons, Applicant respectfully requests the withdrawal of the 35 USC § 102(e) rejections of claims 94, 96, 97, 105-107, and 109-112 over Henningsson.

**II) CLAIM REJECTIONS - 35 USC § 103(a)**

Claims 66, 78, 79, 86. and 92 were rejected under 35 USC 103(a) as being unpatentable over Scharf. [Office Action, Page 5, lines 21-22]. Applicant respectfully traverses this rejection.

Claims 60-99, 101, 102, and 104 were rejected under 35 USC § 103(a) as being unpatentable over U.S. Pat. No. 6,024,500 issued to Wolf ("Wolf") in view of U.S. Pat. No. EP 0652696 A1 issued to Benzoni ("Benzoni"). [Office Action, Page 6, lines 14-15]. Applicant respectfully traverses this rejection.

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." [MPEP § 2142; Original 8<sup>th</sup> Edition, Aug. 2001, Pg. 2100-121].

A. Wolf and Benzoni

Regarding independent claim 60, Applicant respectfully submits that Wolf at least does not disclose a "shielded housing spaced around [a] printed circuit board" as recited in amended claim 60. [Claim 60, lines 8-9].

Regarding independent claim 83, Applicant respectfully submits that Wolf at least does not disclose a "shielded housing spaced apart and wrapped around the first printed circuit board and the second printed circuit board to reduce electromagnetic interference (EMI)" as recited in claim 83. [Claim 83, lines 22-25].

Regarding independent claim 94, Applicant respectfully submits that Wolf at least does not disclose "providing a shielded housing spaced around the first printed circuit board and the second printed circuit board" as recited in amended claim 94. [Claim 94, lines 14-15].

The Office Action alleges that "Wolf does not state whether the PCBs themselves are in direct contact with the housing." [Office Action, Page 6, lines 14-15]. Applicant respectfully disagrees.

Wolf's detailed description clearly states that "[a] first hybrid integrated circuit, 20, [] is mounted on the first sidewall, 12, and a second hybrid integrated circuit, 30, [] is mounted on the second sidewall, 13". [Wolf, Col. 1, lines 59-65]. Moreover, Wolf's Figure 1 does not disclose any space between the sidewalls 12, 13 and the respective circuit boards 21, 31 of the hybrid integrated circuits 20, 30.

The Office Action cites a sentence in Wolf at col. 2, lines 26-30. However, this sentence in Wolf only describes a technique of how the circuits may be mounted to the sidewalls.

"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." [MPEP §2141.02, 8<sup>th</sup> Edition, Rev. 1, Feb. 2003, Pg. 2100-122; citing W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)].

Thus, the combination of Wolf and Benzoni does not make obvious independent claims 60, 83, and 94.

Rejected dependent claims 61-82 depend from independent claim 60. Rejected dependent claims 84-93 depend from independent claim 83. Rejected dependent claims 95-99, 101, 102, and 104 depend from independent claim 94.

Applicant believes that it has placed independent claims 60, 83, and 94 in condition for allowance such that dependent claims depending therefrom with additional limitations are also in condition for allowance.

For the foregoing reasons, Applicant respectfully requests the withdrawal of the 35 USC § 103(a) rejection of claims 60-99, 101, 102, and 104 over the combination of Wolf and Benzoni.

B. Scharf

Rejected dependent claims 66, 78, and 79 depend directly or indirectly from independent claim 60. Rejected dependent claims 86 and 92 depend directly or indirectly from independent claim 83.

Applicant respectfully incorporates herein by reference, its remarks with respect to Scharf from above.

Applicant respectfully submits that Scharf does not make obvious independent claims 60 and 83 and that dependent claims

66, 78, 79; and 86, 92 depending respectfully therefrom with added limitations are also not made obvious.

For the foregoing reasons, Applicant respectfully requests the withdrawal of the 35 USC § 103(a) rejection of dependent claims 66, 78, 79, 86, 92 over Scharf.

III) NEW CLAIMS

Applicant has added new claims 113-116.

New claims 113-116 depend directly or indirectly from independent claim 110.

Applicant believes it has placed independent claim 110 in condition for allowance such that the dependent claims 113-116 depending respectfully therefrom with further limitations are also in condition for allowance.

For the foregoing reasons, Applicant respectfully submits that new claims 113-116 are also in condition for allowance.

1

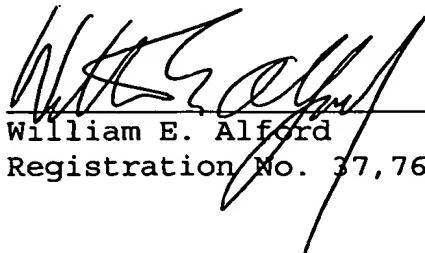
CONCLUSION

In view of the foregoing it is submitted that the claims are in condition for allowance. Reconsideration of the rejection is requested. Allowance of the claims at an early date is solicited.

The Examiner is invited to contact Applicant's undersigned counsel by telephone at (714) 557-3800 to expedite the prosecution of this case should there be any unresolved matters remaining. To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such deposit account.

Respectfully submitted  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

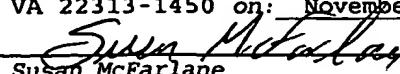
Dated: November 20, 2003

  
\_\_\_\_\_  
William E. Alford  
Registration No. 37,764

CERTIFICATE OF MAILING

12400 Wilshire Boulevard,  
Seventh Floor  
Los Angeles, California 90025  
(714) 557-3800

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450 on: November 20, 2003.

  
\_\_\_\_\_  
Susan McFarlane Date 11/20/03